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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,040	11/21/2005	Susanne Emig	05-549-CIP	2756
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EXAMINER HELM, CARALYNNE E				
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1615				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/555,040

**Applicant(s)**

EMIG ET AL.

**Examiner**

CARALYNNE HELM

**Art Unit**

1615

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 44-92 is/are pending in the application.
- 4a) Of the above claim(s) 51-57, 67-75, 77, 87 and 92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-50, 58-66, 76, 78-86 and 88-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/11/10
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

To summarize the current election, applicants elected, without traverse, Group I and the species where in the polyvalent ester R is a branched hydrocarbon residue with 5 carbons, W=X=Y=Z: -C(O)O- R1=R2=R3=R4: linear long-chain hydrocarbon residue with 21 carbon (pentaerythritol tetrabenate), the emulsifier is cetyl PEG/PPG-10/1 dimethicone, the volatile silicone is decamethyl cyclopentasiloxane and the solids are inorganic pigments.

Claims 51-57, 67-75, 77, 87, and 92 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim.

### ***Claim Objections***

Claim 62 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. This claim recites that "the silicone oil is a non-volatile silicone oil..." yet its parent claim recites the presence of a volatile silicone as opposed to a general silicone oil.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The four factual inquiries of *Graham v. John Deere Co.* have been fully considered and analyzed in the rejections that follow.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 44-50, 58-61, 64-66, 76, 78-80, 86, and 88-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roulier et al. (previously cited) in view of Omura et al. (previously cited), Krzysik et al. (previously cited) and as evidenced by the Abil® EM 90 reference (previously cited).

Roulier et al. teach a set of compositions that are in the form of water-in-oil emulsions (see abstract). The compositions are taught to contain an oily phase with at least one wax and a silicone emulsifier (see claim 1). Abil® EM 90 is one preferred emulsifier (see column 4 lines 7-8). The Abil EM90 reference teaches that this emulsifier is known under the name cetyl PEG/PPG-10/1 dimethicone (see page 1 and page 2 column 1; instant claims 64-66). This emulsifier is taught to be introduced into the composition in a volatile or non-volatile silicone oil, where cyclomethicones are envisioned (see column 3 lines 62-65; instant claim 61). The waxes are envisioned as fatty esters that are solid at 25°C and more particularly have a melting temperature above 65°C (see column 3 lines 4-5 and 8-12; instant claim 44). These waxes are present at from 5% to 15% (see column 3 lines 26-30; instant claims 58-59). The oily phase is also taught to preferably contain additionally fatty substances where volatile silicone oils are envisioned (see column 4 lines 39-40 and 43 and claim 8; instant claim 44). Roulier et al. go on to teach the inclusion of filler materials in the form of zinc oxide, titanium oxide and titanium dioxide as well as sunscreen agents (see column 4 lines 17-26 and column 5 lines 36-37; instant claims 76 and 86). The filler components are present at 1 to 12% (see column 4 lines 53-55; instant claims 78-80). Roulier et al. teach their composition for use to treat, care for, protect or cleanse the skin as well as in

make up products (see column 5 lines 5-18; instant claims 88-90). Roulier et al. do not explicitly teach pentaerythritol tetrabehenate as the fatty ester or decamethyl cyclopentasiloxane as the volatile silicone oil.

Omura et al. teach water-in-oil emulsions for cosmetic compositions (see abstract). These compositions also teach the inclusion of silicone oils in the oily phase and exemplify several particular varieties (see paragraph 37). Decamethyl cyclopentasiloxane is taught within this set of exemplified options (see paragraph 37).

Krzysik et al. teach a set of fatty esters with a melting point above 35°C that are suitable for use in compositions intended to protect or repair skin as well as cosmetic applications (see column 4 lines 5-9 and 14-17 and column 5 lines 45-46 and 64-65). One of these fatty esters that also has the preferred melting point of Roulier et al. is pentaerythritol tetrabehenate (see column 5 lines 45-46 and 64-65, column 6 line 16).

In light of the teachings of Krzysik et al. of functionally equivalent fatty acid esters that are solid at room temperature and are suitable of the applications of Roulier et al., it would have been obvious to one of ordinary skill in the art to select any one of them that meets the preference of Roulier et al. and melts above 65°C. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to select pentaerythritol tetrabehenate from the list of options in Krzysik et al. Additionally, since both Roulier et al. and Omura et al. teach water-in-oil emulsions that include silicone oils in the oily phase, it would have been obvious to select any particular silicone oil taught by Omura et al. to use in the invention of Roulier et al. Thus the selection of decamethyl cyclopentasiloxane would have also been obvious to this ordinarily skilled

artisan. Routine optimization that would have been obvious to one of ordinary skill in the art would have achieved the claimed proportions of volatile- and non-volatile silicone oil (see instant claim 61). According to MPEP 2112.01, "A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present." This treatment results from *In re Spada*, which states that, "Products of identical chemical composition can not have mutually exclusive properties." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Since all the claimed components would have been present in the claimed arrangement in the composition based upon the combined references, and absent evidence to the contrary, the composition would also have the same claimed viscoelastic properties (see instant claim 91). Therefore claims 44-50, 58-61, 64-66, 76, 78-80, 86, and 88-91 are obvious over Roulier et al. in view of Omura et al. and Krzysik et al. as evidenced by the Abil® EM 90 reference.

Claims 44, 61, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roulier et al. in view of Omura et al. and Krzysik et al. as evidenced by the Abil® EM 90 reference as applied to claims 44-50, 58-61, 64-66, 76, 78-80, 86, and 88-91 above, and further in view of Stepniewski et al. (previously cited).

Roulier et al. in view of Omura et al. and Krzysik et al. as evidenced by the Abil® EM 90 reference make obvious the composition of claim 44 with volatile and non-volatile silicone oils. This modified reference does not explicitly teach a particular non-volatile silicone oil.

Stepniewski et al. teach stable water-in-oil emulsions for personal care preparations (see abstract). They go on to teach the inclusion of non-volatile silicone oils in the compositions and provide a listing of several known suitable varieties (see column 3 lines 21-22). Particular non-volatile silicone oils include cetyl dimethicone (see column 3 lines 26-27).

It would have been obvious to one of ordinary skill in the art to select cetyl dimethicone as the non-volatile silicone oil in the invention of Roulier et al. in view of Omura et al. and Krzysik et al. as evidenced by the Abil® EM 90 reference since it was a known particular variety of the non-volatile silicone oil utilized in water-in-oil emulsions as taught by Roulier et al. Therefore claims 44, 61, and 63 are obvious over Roulier et al. in view of Omura et al., Krzysik et al., and Stepniewski et al. as evidenced by the Abil® EM 90 reference.

Claims 44, 76, and 81-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roulier et al. in view of Omura et al. and Krzysik et al. as evidenced by the Abil® EM 90 reference as applied to claims 44-50, 58-61, 64-66, 76, 78-80, 86, and 88-91 above, and further in view of Katsuyama et al. (previously cited).

Roulier et al. in view of Omura et al. and Krzysik et al. as evidenced by the Abil® EM 90 reference make obvious the composition of claim 44 with zinc oxide at the claimed proportion and sunscreen actives (see instant claims 44, 76, and 82). This modified reference does not explicitly teach the size of the zinc oxide particles.



Katsuyama et al. teach ultraviolet-screening zinc oxide particles (see abstract). Specifically, Katsuyama et al. teach the size of zinc oxide particles for sunscreen purposes is 50 nm to 100 nm (see column 2 lines 12-23; instant claim 81). In addition, they teach that the particles can perform their intended screening function when incorporated at 10 wt% into a topical composition (see example 4; instant claim 83).

Since Roulier et al. teaches the incorporation of zinc oxide as well as sunscreen agents, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the zinc oxide particles of Katsuyama et al. as the zinc oxide particles in Roulier et al. in view of Omura et al. and Krzysik et al. and as evidenced by the Abil® EM 90 reference at 50 nm. Therefore claims 44, 76, and 81-83 are obvious over Roulier et al. in view of Omura et al. and Krzysik et al. and Katsuyama et al. as evidenced by the Abil® EM 90 reference.

Claims 44, 76, 81, and 84-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roulier et al. in view of Omura et al., Krzysik et al., and Katsuyama et al. as evidenced by the Abil® EM 90 reference as applied to claims 44-50, 58-61, 64-66, 76, 78-80, 86, and 88-91 above, and further in view of Wendel et al. (previously cited).

Roulier et al. in view of Omura et al., Krzysik et al., and Katsuyama et al. as evidenced by the Abil® EM 90 reference make obvious the composition of claim 44 with zinc oxide nanopigment and sunscreen actives (see instant claims 44, 76, and 81). This modified reference does not explicitly teach both 3-methylbenzylidene camphor and isoamyl p-methoxycinnamate in the composition as sunscreen agents.

Wendel et al. teach compositions with combinations of ultraviolet light filters where zinc oxide particulates less than 300 nm are envisioned (see paragraphs 31-32). Additional UV filters are also taught that include 3-(4-methylbenzylidene) camphor and isoamyl p-methoxycinnamate (see paragraphs 80 and 92; instant claims 84-85).

"It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) see MPEP 2144.06. Therefore since zinc oxide nanopigment, 3-(4-methylbenzylidene) camphor, and isoamyl p-methoxycinnamate are all known as UV filters, it would have been obvious to one of ordinary skill at the time of the invention include all three of them as the sunscreen agents in the composition of Roulier et al. in view of Omura et al., Krzysik et al. and Katsuyama et al. as evidenced by the Abil® EM 90 reference. Therefore claims 44, 76, 81, and 84-85 are obvious over Roulier et al. in view of Omura et al., Krzysik et al., Katsuyama et al., and Wendel et al. as evidenced by the Abil® EM 90 reference.

### ***Response to Arguments***

Applicants' arguments, filed August 11, 2010, 2009, have been fully considered but they are not persuasive.

Applicants note two locales in the rejection where the specific citations in the references did not align with the teaching discussed or was inadvertently omitted. In the

case of the teaching of sunscreen agents in Roulier et al., the referenced citation is located at column 5 lines 36-37. In the case of the teaching of fatty acid esters with a melting point above 35°C by Krzysik et al., the referenced citation is found at column 5 lines 64-65. These citations have been corrected accordingly in the rejection. Even in the absence of the provided specific citations, both Roulier et al. and Krzysik et al. contained the teachings as discussed in the rejection.

Applicants further argue that Roulier et al. do not teach polyvalent esters and that Krzysik et al. do not teach a cosmetic application of their composition besides cosmetic cleansing. While Roulier et al. envision fatty esters, their silence concerning the elected polyvalent ester was noted in the rejection. Applicants appear to suggest in their arguments that Krzysik et al. do not envision cosmetic cleansing, as is instantly envisioned, as a particular variety of the cosmetic applications referenced for their composition. In response to this argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., application as cleansing composition) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, claiming the composition as a "cleansing agent" would be an intended use and such a recitation would not add any structural limitation to the claims.

In addition, applicants argue that Krzysik et al. do not teach the use of polyvalent esters for cosmetic use in general. As applicants note earlier in the arguments, Krzysik

et al. teach their compositions generally for cosmetic use and include polyvalent esters as envisioned components in these compositions. Since Krzysik et al. teach pentaerythritol tetrabehenate as a particular fatty ester that has melting point of 35°C or greater and Roulier et al. contemplate fatty esters that are solid at 25°C and more particularly have a melting temperature above 65°C for their composition, it would have been obvious to select a fatty ester from the listing provided by Krzysik et al. for the composition of Roulier et al. as the substitution of one known element for another to obtain a predictable result. The fatty esters envisioned by both references have overlapping range of melting points and are contemplated for cosmetic applications, therefore this substitution would have had a reasonable expectation of success.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CARALYNNE HELM** whose telephone number is (571)270-3506. The examiner can normally be reached on Monday through Friday 9-5 (EDT).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Wax can be reached on 571-272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Caralynne Helm/  
Examiner, Art Unit 1615

/Juliet C Switzer/  
Primary Examiner, Art Unit 1634